



05-08-06

IFW 2157

HEWLETT-PACKARD COMPANY
Intellectual Property
Administration
P.O. Box 272400
Fort Collins, Colorado 80527-

Docket No.: 10010812-1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Wenting Tang et al.

Application No.: 09/880,631

Confirmation No.: 5913

Filed: June 12, 2001

Art Unit: 2157

For: METHOD AND SYSTEM FOR MODULAR
TRANSMISSION CONTROL PROTOCOL
(TCP) RARE-HANDOFF DESIGN IN A
STREAMS BASED TRANSMISSION
CONTROL PROTOCOL/INTERNET
PROTOCOL (TCP/IP)IMPLEMENTATION

Examiner: G. G. Todd

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed April 6, 2006, applicant hereby provisionally elects claims 1-10 (Group I) for continued examination, WITH TRAVERSE.

Traversal of Restriction as Being Improper

The current Office Action mailed April 6, 2006 requires restriction to one of 3 groups of claims that are alleged to be distinct. The group numberings identified in the current Office Action are used consistently herein, and are as follows:

- I. Claims 1-10;
- II. Claims 11-25; and
- III. Claims 26-37.

As explained further below, Applicant respectfully submits that the 3-way restriction required in the current Office Action is improper and should therefore be withdrawn.

A. No Serious Burden

M.P.E.P. § 803 provides that a restriction is only proper when there would otherwise be “a serious burden on the examiner”. In the instant case, examination of Groups I, II, and III in a common application does not place a serious burden on the examiner. Indeed, all of the pending claims 1-37 have already been examined together, *see* previous Office Actions mailed September 22, 2004 and April 20, 2005, which treated all of claims 1-37. Indeed, all of claims 1-37 have been advanced through prosecution to the point of appeal to the Board. The present restriction requirement is raised responsive to Applicant’s appeal brief submitted January 5, 2006. Accordingly, as the claims of Groups I, II, and III have already been subject to examination, no “SERIOUS burden” is placed on the Examiner in continuing to examine the present application with the claims of Groups I, II, and III.

If “the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” M.P.E.P. § 803. Thus, a proper restriction has not been made in this case at least because a serious burden on the Examiner has not been established.

Further, the Examiner asserts that claims 1-10 of Group I are “drawn to a method of TCP state migration, classified in class 709, subclass 227”, *see* Page 2 of the Office Action. The Examiner further asserts that claims 26-37 of Group III are “drawn to a server computer architecture for centralized data routing, classified in class 709, subclass 244”. *Id.* However, claim 26 makes no mention of “centralized data routing”. Further, as with claims 1-10, claim 26 recited “migrating TCP states”. Thus, Applicant fails to understand the differing classifications of these claims, particularly in view of all of the claims having been already searched and examined together.

For at least the above reasons, the restriction of Groups I-III should be withdrawn.

B. Burden for Establishing Prima Facie Case of Restriction is Not Met

The Office Action asserts that the claims of Groups I-III are related as combination and subcombination. M.P.E.P. § 806.05 explains that claims related in this manner “are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and nonobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination.”

While the current Office Action alleges on page 3 that the claims of Groups I-III do not require the particulars of each other, the Office Action fails to establish separate utility for the subcombination. M.P.E.P. § 806.05(c) makes clear that the “burden is on the examiner to suggest an example of separate utility.” Such an example is lacking in the current Office Action, but instead provides merely conclusory statements regarding certain elements of a Group not required in other Groups.

For at least the above reasons, the restriction as between Group I-III has not been established and should be withdrawn.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10010812-1 from which the undersigned is authorized to draw.

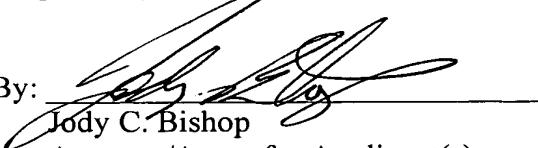
I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 568257255US in an envelope addressed to: M/S Amendment, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: May 5, 2005

Typed Name: Gail L. Miller

Signature: Gail L. Miller

Respectfully submitted,

By: 

Jody C. Bishop
Attorney/Agent for Applicant(s)
Reg. No. 44,034
Date: May 5, 2006
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PATENT APPLICATION

ATTORNEY DOCKET NO. 10010812-1

Inventor(s): Wenting Tang et al.

Confirmation No.: 5913

Application No.: 09/880,631

Examiner: G. G. Todd

Filing Date: June 12, 2001

Group Art Unit: 2157

METHOD AND SYSTEM FOR MODULAR TRANSMISSION CONTROL PROTOCOL (TCP) RARE-
Title: HANDOFF DESIGN IN A STREAMS BASED TRANSMISSION CONTROL PROTOCOL/INTERNET
PROTOCOL (TCP/IP) IMPLEMENTATION

Mail Stop Amendment
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Transmitted herewith is/are the following in the above-identified application:

Response/Amendment
 New fee as calculated below
 No additional fee
 Other

Petition to extend time to respond
 Supplemental Declaration

Fee\$

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	37	MINUS	37	= 0	X \$50	\$ 0
INDEP. CLAIMS	3	MINUS	3	= 0	X \$200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+	\$360
EXTENSION FEE	<input type="checkbox"/> 1st Month \$120	<input type="checkbox"/> 2nd Month \$450	<input type="checkbox"/> 3rd Month \$1020	<input type="checkbox"/> 4th Month \$1590		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

Express Mail Label No.: EV 568257255US

Respectfully submitted,

Date of Deposit: May 5, 2006

Wenting Tang et al.

Typed Name: Gail L. Miller

By

Signature: Gail L. Miller


Jody C. Bishop

I hereby certify that this is being deposited with the
United States Postal Service "Express Mail Post Office
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Commissioner for Patents, Alexandria, VA 22313-1450

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